

**REMARKS**

Applicants acknowledge receipt of the Office Action mailed January 16, 2009.

In the Office Action, the Examiner rejected claims 69-74, 77-79, 82, 83, 86, 88, and 89 under 35 U.S.C. § 112, second paragraph; rejected claims 69-73, 79, 86, and 88 under 35 U.S.C. § 102(b) as being anticipated by *Takahashi et al.* (U.S. Patent No. 6,080,363); rejected claims 74, 78, 82, 83, and 89 under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi* in view of *Goldbecker et al.* (U.S. Patent No. 5,601,650); and indicated that claim 77 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph, and to include all of the limitations of the base claim and any intervening claims.

In this Amendment, Applicants amend claims 69 and 86, and cancel claim 77, without prejudice or disclaimer. Upon entry of this Amendment, claims 49-74, 78, 79, 82-86, 88, 89, and 91-98 will remain pending, with claims 49-68, 84, 85, and 91-98 withdrawn from consideration. Of the claims under examination, claims 69 and 86 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 69 and 86. No new matter has been introduced.

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter in claim 77. Consequently, solely to expedite prosecution, Applicants have amended independent claims 69 and 86 to include the features of allowable claim 77, and have cancelled claim 77. Accordingly, independent claims 69 and 86 are in condition for allowance. In addition, claims 70-74, 78, 79, 82, 83, 88, and 89 are in

condition for allowance at least due to their corresponding dependence from independent claims 69 and 86.

Applicants traverse the rejections above and respectfully request reconsideration for at least the reasons that follow.

**I. 35 U.S.C. § 112, SECOND PARAGRAPH, REJECTION**

Claims 69-74, 77-79, 82, 83, 86, 88, and 89 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential elements.

Specifically, the Examiner asserts that, with respect to claim 69, the omitted elements are: "the element which rotates the slide in the slide rack from the substantially vertical disposition to a substantially horizontal disposition." (*Office Action*, p. 2, para. 3). Applicants submit that the rejection of claim 69 has been rendered moot by the amendments to claim 69, and similarly claim 86. Applicants have amended claims 69 and 86 to include, for example, the limitation of claim 77, which recites "a slide positioner element adapted to rotate said slide to the substantially vertical disposition for submerging the slide into the fluid and into the substantially horizontal disposition for application of said at least one reagent to said at least one tissue sample."

In addition, the Examiner asserts that "there is no antecedent basis for the transfer tank, supply tank and at least one waste tank" in claim 83. (*Office Action*, p. 3, II. 3-4). Applicants respectfully disagree. Applicants submit that the claims contain no earlier recitation or limitation of the terms "at least one transfer tank", "a supply tank", and "at least one waste tank", where it would be unclear as to what element each limitation was making reference. Furthermore, claim 83 is not indefinite because the

scope of the claim is reasonably ascertainable by those skilled in the art. Applicants therefore request that the rejection of claims 69-74, 77-79, 82, 83, 86, 88, and 89 under 35 U.S.C. § 112, second paragraph, be withdrawn.

**II. 35 U.S.C. § 102(b) REJECTION**

Applicants traverse the rejection of claims 69-73, 79, 86, and 88 under 35 U.S.C. § 102(b) as being anticipated by *Takahashi*. Although Applicants do not agree with the Examiner's rejection, Applicants have amended claims 69 and 86 to include the features of allowable claim 77 in order to expedite prosecution. It is those features which the Examiner admits are not disclosed in either *Takahashi* or any other prior art of record. (*Office Action*, p. 8, para. 11). Accordingly, independent claims 69 and 86, and claims 70-73, 79, and 88 which correspondingly depend therefrom, are patentable over *Takahashi*. Applicants therefore request that the rejection of claims 69-73, 79, 86, and 88 under 35 U.S.C. § 102(b) be withdrawn.

**III. 35 U.S.C. § 103(a) REJECTION**

Applicants respectfully traverse the rejection of claims 74, 78, 82, 83, and 89 under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi* in view of *Goldbecker*.

Applicants have amended claims 69 and 86 in order to expedite prosecution. As explained above, the Examiner has indicated that the elements of independent claims 69 and 86, as amended, are patentable over the cited art. Claims 74, 78, 82, 83, and 89 depend from independent claims 69 and 86 and require all elements thereof.

Applicants therefore request that the rejection of claims 74, 78, 82, 83, and 89 under 35 U.S.C. § 103(a) be withdrawn.

#### IV. CONCLUSION

Applicants respectfully submit that claims 69-74, 78, 79, 82, 83, 86, 88, and 89 are in condition for allowance.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By



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